

REMARKS

With entry of this amendment, claims 1, 25, and 27 have been amended, claims 2-24, 26, and 28-43 have been cancelled, and claims 44-85 have been newly added. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Restriction

Claims 37-43, which stand withdrawn from further consideration under 37 C.F.R. §1.142(b) as being drawn to a non-elected invention, have been cancelled from this application.

Claim Rejections-35 U.S.C. §112

Claims 12, 15, and 31, which stand rejected as being indefinite under 35 U.S.C. §112, second paragraph, have been cancelled, thereby rendering the rejections of these claims moot.

Claim Rejections-35 U.S.C. §102

Ream

Claims 1-3, 13, 16-18, 21-23, 25-28, and 30-36 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,972,012 ("Ream"). Claims 2-3, 13, 16-18, 21-23, 26, 28, and 30-36 have been cancelled from this application, thereby rendering the rejections of these claims moot. Applicant respectfully traverses the rejections of the remaining claims 1, 25, and 27, since Ream does not disclose each and every element required by these claims.

In particular, independent claim 1 requires the processing device to be user programmable, such that the user can define an association between a medical function and a specific manner in which the actuating element is actuated. In contrast, Ream merely discloses the ability to program a controller 34 with the depth of the transmural channels that will be cut by the apparatus 10 (col. 9, line 67 to col. 10, line 4). In this case, the transmural channel depth modification (i.e., the function that is programmed) is not the function that is initiated by actuation of the actuating element (i.e., button 17b), and thus, this function is not associated with a specific manner in which the button 17b is actuated. Rather, the function that is initiated by actuation of the button 17b is the cutting of the transmural channel itself, and its association with the specific manner in which the button 17b is actuated cannot be defined by the user. That is, the transmural function can only be initiated by a single depression of the button 17b and no other button, and a single depression of the button 17 will only initiate the transmural function and no other function, and there is nothing that a user can do to change this association.

Independent claim 25 requires the actuating element to be configured for initiating a plurality of different medical functions in a predetermined sequence. In contrast, each of the actuating elements 17a-17c disclosed in Ream initiates only one function (i.e., aspiration for button 17a, cutting for button 17b, and stabilization for button 17c) (col. 10, lines 5-52). There is no single actuating element disclosed in Ream that is capable of initiating a sequence of different medical functions.

Independent claim 27 requires the actuating element to be configured for initiating at least two different functions when respectively actuated in at least two different manners. Not only does each of the actuating elements 17a-17c disclosed in Ream initiate only one

function, each of the actuating elements 17a-17c is only disclosed as being actuated in one manner, i.e., a single depression of the respective button.

Thus, Applicant submits that independent claims 1, 25, and 27 are not anticipated by Ream, and as such, respectfully requests withdrawal of the §102 rejections of these claims with respect to Ream.

Swanson

Claims 27, 28, 30, and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,142,994 ("Swanson"). Claims 28, 30, and 35 have been cancelled from this application, thereby rendering the rejections of these claims moot. Applicant respectfully traverses the rejection of the remaining claim 27, since Swanson does not disclose each and every element required by this claim.

As previously described, independent claim 27 requires the actuating element to be configured for initiating at least two different functions when respectively actuated in at least two different manners. In contrast, each of the switches 315 disclosed in Swanson initiates only one function (i.e., activating an electrode) in only one manner (i.e., depressing the respective switch 315).

Thus, Applicant submits that independent claim 27 is not anticipated by Swanson, and as such, respectfully requests withdrawal of the §102 rejection of this claim with respect to Swanson.

Burdorff

Claims 1-8, 12-23, 25, 26, and 30-36 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,428,487 ("Burdorff"). Claims 2-8, 12-23, 26, and 30-

36 have been cancelled from this application, thereby rendering the rejections of these claims moot. Without acquiescing that Burdorff is, in fact, a §102(e) prior art reference, and without prejudice to antedate the effective filing date of Burdorff should it become necessary, Applicant respectfully traverses the rejections of the remaining claims 1 and 25, since Burdorff does not disclose each and every element required by these claims.

As previously described above, independent claim 1 requires the processing device to be user programmable, such that the user can define an association between a medical function and a specific manner in which the actuating element is actuated. In contrast, Applicant can find nowhere in Burdorff disclosing a feature that allows a user to define an association between a function (such as, one of the cutting and aspiration functions) and a specific manner in which one of the buttons 46, 48, 50 is actuated. That is, respective actuation of the buttons 46, 48, 50 initiates forward, reverse, and vacuum functions, and there does not appear to be any disclosure that allows a user to modify the association of these functions with the manner in which the buttons 46, 48, 50 are actuated (e.g., by associating the forward function, instead of the vacuum function, with button 50, or requiring the button 50 to be depressed twice, instead of once, to initiate the vacuum function).

Independent claim 25 requires the actuating element to be configured for initiating a plurality of different medical functions in a predetermined sequence, wherein at least two of the medical functions are respectively initiated in response to at least two actuations of the actuating element when repeatedly actuated. In contrast, Burdorff discloses the initiation of a sequence of different functions in response to a single depression of a button. (see col. 11, lines 11-35).

Thus, Applicant submits that independent claims 1 and 25 are not anticipated by Burdorff, and as such, respectfully requests withdrawal of the §102 rejections of these claims with respect to Burdorff.

Malackowski

Claims 1-9 and 16-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication US 2001/0034530 ("Malackowski"). Claims 2-9 and 16-23 have been cancelled from this application, thereby rendering the rejections of these claims moot. Without acquiescing that Malackowski is, in fact, a §102(e) prior art reference, and without prejudice to antedate the effective filing date of Malackowski should it become necessary, Applicant respectfully traverses the rejection of the remaining claim 1, since Malackowski does not disclose each and every element required by this claim.

In particular, as previously described, independent claim 1 requires the processing device to be user programmable, such that the user can define an association between a medical function and a specific manner in which the actuating element is actuated. In contrast, Malackowski does not disclose the ability of a user to be able to define an association of a medical function with any of the buttons 608, 610, 612. Rather, the user can only define an association between menu navigation and selection functions, which are not medical functions, with the buttons 608, 610, 612 (see paragraph [0084]).

Thus, Applicant submits that independent claim 1 is not anticipated by Malackowski, and as such, respectfully requests withdrawal of the §102 rejection of this claim with respect to Malackowski.

Claim Rejections-35 U.S.C. §103

Claims 10, 11, 24, and 29 stand rejected under 35 U.S.C. §103 as being obvious over various combinations of Malackowski, Swanson, U.S. Patent Publication 2003/0050633 ("Ellman"), Ream, and U.S. Patent No. 4,170,234 ("Graham"). Claims 10, 11, 24, and 29 have been cancelled from this application, thereby rendering the rejections of these claims moot.

New Claims

Newly added claims 44-85, which find support in the originally filed application, are believed to be patentable over the prior art. In particular, claims 44-69 depend from independent claims 1, 25, and 27, which are believed to be patentable as discussed above.

Independent claim 70, as well as the claims depending therefrom (claims 71-73), require the actuating element to be configured for initiating at least two different medical functions when respectively actuated different numbers of times within a defined period of time. None of the cited prior art references discloses this feature. Notably, although the vacuum button 50 disclosed in Burdoff is capable of initiating an aspiration function in response to a single click, and a menu scrolling function in response to a double click, a menu scrolling function is not a medical function.

Independent claim 74, as well as the claims depending therefrom (claims 75-78), requires the user programmable processing device to be configured for allowing a user to define a specific manner in which an actuating element is actuated to initiate a medical function. None of the prior art discloses a user programmable processing device that has this feature. Notably, although Malackowski discloses a processing device that allows the

navigation functions of control buttons to be interchanged, there is no disclosure relating to the user modification of the manner in which these control buttons are actuated.

Independent claim 79, as well as the claims depending therefrom (claims 80-83), requires the processing device to be configured for presenting a list of different medical functions, wherein the actuating element is configured for being actuated to advance through the medical function list and for being actuated to select initiation of one of the medical functions. None of the prior art discloses a processing device that has this feature. Notably, although Malackowski and Burdorff disclose processing devices that allow a user to navigate through a medical list and select initiation of one of the medical functions, both require the actuation of several buttons to perform the navigation and selection functions.

Independent claim 84, as well as the claim depending therefrom (claim 85), requires the processing device to mark or highlight a displayed image when an actuating element is actuated. None of the prior art discloses a processing device capable of doing this in conjunction with the actuation of an actuating element located on the handle of a probe shaft handle.


Conclusion

Based on the foregoing, it is believed that, with entry of this amendment, all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has

any questions or comments regarding this amendment, the Examiner is respectfully
requested to contact the undersigned at (714) 830-0600.

Respectfully submitted,

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